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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,908	07/25/2003	Jiande Chen	79109 (6328)	3453
22242	7590	01/19/2006	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			KAHELIN, MICHAEL WILLIAM	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,908

Applicant(s)

CHEN, JIANDE

Examiner

Michael Kahelin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The amendments to the specification are accepted and the resubmitted written disclosure is lacking the features to which were previously objected. Therefore, all objections to the specification are withdrawn.

Claim Objections

2. The amendments to the claims in response to the claim objections are acknowledged and accepted. The objections to claims 4, 12, 13, and 15 are withdrawn.

Response to Arguments

3. Applicant's arguments filed 12/19/2005 have been fully considered but they are not persuasive. Applicant argued on the grounds that Chen et al. (US 5,690,691 hereinafter "Chen") do not disclose stimulating the small intestine alone to prevent or slow stomach emptying and that Chen teaches that stimulation of the bowel will only effect the bowel, not the stomach. However, as Applicant correctly describes on page 9, Chen's invention stimulates the major gastro-intestinal tract organs concurrently. Since independent claims 1 and 11 use the open-ended "comprising" phraseology, the claims do not require that stimulation is provided to the small intestine alone. Furthermore, since the gastro-intestinal tract is a closed system, slowing motility in the small intestine will inherently slow stomach emptying and slow food transit through the

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digestive system. Finally, Chen discloses in column 8, lines 39-50 that disrupting the rapid movement of food through the small bowel with retrograde pacing will prolong the time food is kept in an obese person's stomach, thereby disclosing that stimulating the small intestine will slow stomach emptying.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (5,690,691).

3. In regards to claims 1 and 11, Chen et al. disclose multiple implantable devices comprising leads (70'-87') with connectors for attachment to a pulse generator (18, 20, and 22), wherein the leads are adjacent to the small intestine and provide electrical stimulation (Fig. 5, elements 74-81).

4. In regards to claims 2, 12, and 13, electrical stimulation is provided to the duodenum (74) and the jejunum (77).

5. In regards to claims 3-6 and 14-17, the electrical stimulation provided is in the range of 2 to 15 pulses per minute (col. 9, line 29), about 0.1 to about 4 seconds (col. 9, line 36), and has a pause of 3-30 seconds between pulses (inherent of a frequency of 9-12.5 pulses per minute and duration of 0.1 sec.).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Mintchev et al. (6,449,511). Chen et al. disclose the essential features of the claimed invention except for pulses comprising micro-bursts within the frequency range of 5 to 100 Hz. Mintchev et al. teach of a gastrointestinal stimulator which applies electrical stimulation in bursts in the frequency range of 5-500 Hz (col. 19, line 15) to produce local circumferential contractions without causing any significant damage to the tissues (col. 19, line 51). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chen et al.'s invention by providing stimulation in bursts of 5 to 100 Hz to produce local circumferential contractions without causing any significant damage to the tissues.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWK




GEORGE R. EVANISKO
PRIMARY EXAMINER

1/12/6